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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/669,056	06/24/1996	BRUCE NACHMAN	INFINITY-3.0	1657
7590 08/12/2004				
MARVIN NACHMAN 315 SAYBROOK RD VILLANOVA, PA 19085		EXAMINER LEE, CHEUKFAN		
		ART UNIT PAPER NUMBER		
		2622		

DATE MAILED: 08/12/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

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## Office Action Summary

Application No.

08/669,056

Applicant(s)

NACHMAN ET AL.

Examiner

Cheukfan Lee

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 27, 29, 32-34, 36, 38-48 and 52-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 34, 43-46, 48 and 52 is/are allowed.
- 6) ☒ Claim(s) 27, 29, 32, 33, 41, 36, 38, 39, 40, 42, 47, 53, and 54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                            | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

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1. Claims 27, 29, 32-34, 36, 38-48, and 52-54 are pending. Claims 27, 34, 36, 43, 52, 53, and 54 are independent.
2. Applicant's arguments with respect to the claims 27, 29, 32, 33, 41, 36, 38, 39, 40, 42, 47, 53, and 54 have been considered but are moot in view of the new ground(s) of rejection.
3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 27, 29, 32, 41, 36, 39, 40, 42, 47, 53, and 54 are rejected under 35 U.S.C. 102(e) as being anticipated by Schlank et al. (U.S. Patent No. 6,134,017).

Regarding claim 27, Schlank et al. discloses a system and a method as claimed. A computer (computing equipment 10) and a facsimile machine (18) are connected to each other using a bi-directional direct connection via a passive link (digital bi-directional IEEE 1284 interface, Figs. 1-4, col. 3, line 48 – col. 9, line 30). The facsimile machine (18) is used as a scanner and a printer for the computer (10) as claimed.

In the fax-pc mode, the fax (18) and computer are inherently isolated from a public networking telephone line (i.e., unplugged from the telephone line), and both the computer and facsimile machine are conditioned to send and receive image digital signals. The computer receiving the image digital signals processes the signals.

Regarding claim 29, after inherently isolating from the public telephone line (unplugged), the facsimile apparatus (18) is connected to an appropriate receiving port of the computer (10). See Figs. 1 and 4 and corresponding explanation.

Regarding claim 32, a parallel data source signal of a scanned image is transferred from the facsimile machine (18) to the computer through the parallel port (30) (col. 4, lines 20-35, col. 5, lines 7-45).

Regarding claim 41, Schlank et al. further discloses an OCR translator in the computer (10) for converting received fax data into character codes (col. 10, lines 10-25 and col. 12, lines 60-65).

Regarding claim 36, the method of Schlank et al. also meets the claimed method. Claims 36 reciting a "digital connector port" and "making a facsimile machine operatable as a scanner and a printer" is also met by Schlank et al. discussed above because of the digital connector port (30) and the using or making of the facsimile machine operatable as both a scanner and a printer for the computer.

Regarding claim 39, the parallel connector ports (30) read on the claimed parallel connector ports.

Regarding claim 40, "parallel" digital connectors are taken as a claim limitation among the limitations "RS 232", "parallel" digital ports and "other suitable" digital port type connectors for the purpose of this rejection. The connectors (30) of Schlank et al. are parallel digital port type connectors as discussed above.

Regarding claim 42, as discussed for claim 41, Schlank et al. further discloses an OCR translator in the computer (10) for converting received fax data into character codes (col. 10, lines 10-25 and col. 12, lines 60-65).

Regarding claim 47, the claim recites "using analog or digital serial, or parallel data transmissions". For the purpose of this rejection, "digital" "parallel data transmissions" is chosen to be the claim limitation (since the use of "or" allows one "or" the other to be chosen as a claim limitation for the purpose of a rejection). Independent claim 43, upon which claim 47 depends, is allowable as indicated below because claim 43 is adequately supported by the original specification of the parent application serial number 08/226,278 filed April 11, 1994, and Schlank filed Nov. 14, 1994 does not constitute prior art against claim 43. However, the chosen limitation of claim 47, i.e., digital parallel data transmissions, in combination with other limitations of claim 47 as a whole, is not adequately supported by the specification of parent application 08/226,278 but supported by the present CIP application filed June 24, 1996. Thus, claim 47 is rejected in the manner addressed below.

Claim 47 is understood to including its own limitations and the limitations of claim 43 upon which claim 47 depends. In this case that the data being transferred or

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transmitted are digital parallel data. Schlank et al. discussed for claims 27 and 36 above meets all claimed limitations. Please refer to discussions for claims 27 and 36. In addition, it is a known and inherent feature that each of the facsimile machine and computing device of Schlank communicates using telephone types of circuits when not in the fax-pc mode. In establishing the fax-pc mode, the fax (18) and computer are inherently isolated from a public networking telephone line (i.e., unplugged from the telephone line), the facsimile machine is configured to communicate with the computer and is arranged to be in a connection mode. The computer or computing device is also shifted to the connection mode for sending and receiving digital signals in facsimile format through the IEEE 1284 digital, bi-directional parallel interface, the computer being equipped with send/receive driver communications software enabling the transfer of the scanning and printing signals between the computer and the facsimile machine as claimed.

Regarding claims 53 and 54 are also met by Schlank et al. discussed above since claim 53 claims "transfer of digital image data" (see part (a)) and claim 54 claims "a digital connector port" on the facsimile machine and "a digital connector port" on the computer.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 33, 38 and are rejected under 35 U.S.C. 103(a) as being unpatentable over Schlank et al. (U.S. Patent No. 6,134,017) in view of Nehowig et al. (U.S. Patent No. 5,823,689).

Regarding claims 33 and 38, Schlank et al. discussed for claims 27 and 36 above differs from the claimed invention in that Schlank et al. employs an IEEE 1284 interface for data transfer between the computing device and the facsimile machine, which interface is a digital bi-directional parallel interface, whereas the claimed invention transfers a digital serial data source signal of a scanned image.

Nehowig et al. teaches that an RS-232 serial connection and an IEEE 1284 parallel connection can be interchangeably used for connection between a computing device (11) and an image data output machine (printing machine 15) (col. 6, lines 36-55).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the IEEE 1284 parallel interface (ports) of Schlank et al. with an RS-232 serial port(s) as taught by Nehowig et al. in order to provide the system with more flexibility in the type of interface (ports) to be employed.

7. Claims 34, 43-46, 48, and 52 are allowed.

8. The following is an examiner's statement of reasons for allowance:

Claims 34, 43-46, 48, and 52 are allowable over the prior art of record because the subject matter claimed are adequately supported by the specification of parent application serial number 08/226,278 filed April 11, 1994, and the closest prior art, Schlank et al. (U.S. Patent No. 6,134,017) filed Nov. 14, 1994 does not have an effective filing date earlier than that of 08/226,278.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheukfan Lee whose telephone number is (703) 305-4867. The examiner can normally be reached on 9:30 a.m. to 6:00 p.m., Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Cheukfan Lee  
July 23, 2004



Cheukfan Lee